

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Timo Juhani Kangas

Application No.: 10/088,926

Confirmation No.: 2678

Filed: March 20, 2002

Art Unit: 3625

For: METHOD AND ARRANGEMENT FOR
DISTRIBUTING INFORMATION AND
SERVICES THROUGH A NETWORK

Examiner: J. H. Zurita

APPELLANTS' RESPONSE TO EXAMINER'S ANSWER

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this Response to the Examiner's Answer in accordance with 37 C.F.R. § 41.41 in support of their appeal from the Final Office Action, mailed December 15, 2005 by Examiner Khanh Q. Dinh, and the Advisory Action, mailed June 7, 2006, in the above-identified patent application.

I. STATUS OF CLAIMS

Claims 1-13 are pending in the application.

The current status of the application's claims is as follows:

1. Claims canceled: none;

2. Claims withdrawn from consideration but not canceled: none;
3. Claims pending: 1-13;
4. Claims allowed: none;
5. Claims rejected: 1-13.

This appeal is in respect of the rejection of claims 1-13.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1) Whether Goldhaber discloses each and every element of claims 1-6 and 8-10, as required under 35 U.S.C. § 102(b).

2) Whether claims 7 and 13 can properly be rejected as obvious under 35 U.S.C. § 103(a) based on the combination of Goldhaber and the Examiner's statement of what was known in the art at the time of the invention.

III. ARGUMENT

Applicant responds to the position taken in the Examiner's Answer as follows.

First Ground of Rejection – Rejection of claims 1, 8, 9, 11-12 under 35 U.S.C. § 112(a)

This rejection has been withdrawn by the Examiner.

Second Ground of Rejection – 102(b) rejection of claims 1-6, 8-10

Claims 1 through 6 require “transmitting... *a preliminary order for crediting accounts* associated with the intended recipients” and after sending information or a service to the recipient, “as a response to an indication of a certain recipient having accessed said piece of information or service, *crediting an account* associated with said certain recipient.” Claims 8 through 10 require a “means for transmitting...*a preliminary order for crediting the accounts* associated with the certain subscribers”, “means for providing an indication of a certain recipient having accessed a piece of information or service” and a “means for responding to said indication by *crediting an account* associated with said certain recipient.” (emphasis added).

In essence, the above limitations of Claims 1 through 6, and 8 through 10 are to an escrow feature in an information distribution system. The requirement of a “preliminary order for crediting accounts” of intended recipients places the service providers’ payment (e.g., money) into the hands of an account server (e.g., a third party). The information or service is then sent to the intended recipient. The service provider’s payment is only made (“credited”) to the recipient “as a response to an indication of a certain recipient having accessed said piece of information or service.” In other words, the service provider’s payment is held by the account server and only released after the recipient has fulfilled the obligation to access the information or service. The invention provides security for the transaction for both the service provider who wants the

information or service opened, and the recipient who seeks payment for opening the information or service. The advantage of this system for the recipient is disclosed by the specification as:

Those embodiments where the service provider transmits a preliminary crediting order to the account server before transmitting the information or service to the subscriber terminals are more advantageous than the embodiment of Fig. 4 in the sense that they reduce the service provider's chance for cheating: nothing actually guarantees that the service provider will actually transmit the crediting order in the embodiment of Fig. 4 [which lacks a preliminary crediting order].

PCT Pub. No. WO 01/24071 A1, at p. 9, lines 20-25. Likewise, the advantage of this system for the service provider is disclosed by the specification as:

The simplest way of discouraging cheating attempts is to store at the account server beforehand the list of accounts that are qualified for crediting as shown above at steps 303 and 303', and to cross-correlate that list with the crediting orders so that only qualified accounts can be credited, and every qualified account can be credited only once.

PCT Pub. No. WO 01/24071 A1, at p. 10, line 35 to p. 11, line 2.

In the Examiner's Answer, the Examiner asserts that Goldhaber discloses the claimed escrow feature by citing to the FIG. 2 embodiment of Goldhaber. *See* Examiner's Answer, at 3, 4 and 7. In this embodiment of Goldhaber, the consumer is provided with an offer for information (shown valuable information such as a television program, music, magazine or the like with a price tag) which the consumer may purchase by authorizing a clearing house to debit her account. The Examiner appears to assert that the recited "preliminary order for crediting account" is the information with a price tag of Goldhaber, for example, an offer to provide music for a certain price.

This is a misinterpretation for the meaning of a "preliminary order for crediting accounts" provided by the specification. As set forth above, the specification provides a difference between the claimed "preliminary order for crediting accounts" and subsequent "crediting an account." The first (i.e., the preliminary order) is a transfer of payment to the account server with a preliminary allocation to the accounts of the intended recipients. The second (i.e., the crediting an

account) is the completion of the transaction, or the actual placement of payment into the recipient's account, caused by the recipient's opening of the information or service (which sends a signal to the account server to complete the transaction). Goldhaber does not disclose this two step transaction. Rather, Goldhaber discloses two types of transactions in which payment is completed before the information is accessible: (1) a consumer purchasing valuable information by providing digital cash or authorizing a financial clearinghouse to debit her account (col. 10, lines 9-38; "Upon receipt of such payment or payment authorization, the information provider may release the valuable information..."); or (2) an information provider paying a consumer by providing digital cash or authorizing a financial clearinghouse to credit the consumer's account (col. 10, lines 39-57; "In response to paying attention to the information 56, the information provider compensates the consumer by providing payment...").

In addition, the Examiner combines two completely separate embodiments to find the claimed invention in Goldhaber. The Examiner cites to the FIG. 2 embodiment where a consumer is purchasing valuable information in finding the "transmitting through the computer or cellular network a preliminary order for crediting accounts" limitation. But then the Examiner cites the FIG. 3 embodiment where a consumer is paid to view information in finding the "crediting an account associated with said certain recipient" limitation. These embodiments are inconsistent because the "account" being credited is different in each embodiment, the information provider's account is credited in the FIG. 2 embodiment, while the recipient's account is being credited in the FIG. 3 embodiment. The Examiner cannot pick and chose features of different and inconsistent embodiments to find the claimed invention in the prior art. *See Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pt. App. & Inter. 1984) ("The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.").

Third Ground of Rejection -- 103(a) of claims 7 and 13 over Goldhaber

In defense of taking official notice of knowledge of one of skill in the art to reject claims 7 and 13, the Examiner argues that Appellant has not adequately traversed the Examiner's finding, denies using hindsight and references Goldhaber as disclosing coupons which are time sensitive to justify modifying the prior art to find the claimed invention obvious.

"To adequately traverse... a finding [taking official notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." MPEP § 2144.03. *See* 37 C.F.R. § 1.111(b). In the first Office Action, the Examiner rejected claim 7 by stating that "Goldhaber discloses the use of time-sensitive incentives such as coupons... It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Goldhaber to disclose time sensitive credits, perhaps based on a subscriber's response time." March 9, 2005 Office Action, at p. 10. Applicant responded by arguing that "Goldhaber does not even suggest that its coupons are time-sensitive. And even assuming that Goldhaber were to suggest that the coupons were time-sensitive, it would not have been obvious to one of ordinary skill in the art to take such a leap in logic to arrive at crediting the account by an amount which is inversely proportional to the time." June 3, 2005 Amendment, at p. 8. Applicant's response is a clear statement of why the "noticed fact" is not considered to be well-known in the art. As such, the Examiner's argument that there was no adequate traversal is not well-founded.

The issue is whether the disclosure of a coupon, without reference to whether such coupons are time sensitive, is sufficient to render the claimed invention obvious over Goldhaber. Appellant set forth in its opening brief that a coupon which either has value or no value provides no teaching, suggestion or motivation to assign a value to a transaction that is in inverse proportion to the time it takes a recipient to access a piece of information. The Examiner did not provide a response to this position, other than to deny using hindsight and once again simply state that "Goldhaber discloses the use of coupons, which are time sensitive." Examiner's Answer, at p. 10.


This is insufficient to justify maintaining an obviousness rejection. In addition, the only thing time sensitive about coupons known in the art is their expiration date. The coupon will have the same value over time until it expires, when its value drops to zero. Thus, nothing would justify the Examiner's contention that this time sensitivity would indicate a change in value inversely proportional to time.

IV. CONCLUSION

For all of the reasons set forth above, the rejections of claims 1-13 should be reversed. Appellant respectfully requests that the application be remanded to the Primary Examiner with an instruction to withdraw the rejections, and pass the case to allowance.

Respectfully submitted,

Dated: September 28, 2007

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